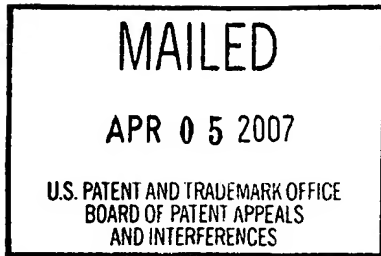


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID T. KRICK, JOSEPH F. O'SULLIVAN and MICHAEL S. WEST

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Application No. 10/802,378

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences (BPAI) on December 8, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On December 30, 2005, in response to the examiner's notification of Non-Compliant Appeal Brief (filed on July 26, 2005), appellants filed a revision to the "Summary of the Claimed Subject Matter". The BPAI does not find the revision to be fully compliant.

37 CFR § 41.37(c)(1)(v) defines the heading's requirements as follows:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved

in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For **each independent claim involved in the appeal and for each dependent claim argued separately** under the provisions of paragraph (c)(1)(vii) of this section, **every means plus function and step plus function** as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function **must be set forth with reference to the specification by page and line number, and to the drawing, if any**, by reference characters. (Emphasis added.)

The item remains defective because the summary fails to **separately** identify each independent claim involved in the appeal (claims i.e., 1, 9, 16 and 23) and does not specifically map the subject matter of each of the independent claims to its location in the specification as outlined above. A paper correcting the deficiency is required.

Another matter that needs to be resolved before returning the application to the BPAI is the examiner's failure to list the evidence relied upon in his rejection(s) of the appealed claims. Page 3 of the examiner's answer contains a section heading titled **"(8) Evidence Relied Upon"** that states "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal" beneath it.

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The Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) defines the above heading as follows:

(8) *Evidence Relied Upon*. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

As per the above, the Hampel and Ralpisarda references as well as any other evidence relied upon by the examiner in the rejection(s) of the appealed claims should be listed beneath the evidence heading. Correction is required.


Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) hold the Appeal Brief filed on December 30, 2005, defective;
- 2) notify appellants to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v),
- 4) mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer, and;
- 5) for such further action as may be appropriate.

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

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PJN/vsh

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